

identically claimed invention is placed into possession of one having ordinary skill in the art.

*Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Each of independent claims 1, 9 and 10 require the feature that data specification information required for converting source files into a calibrating file be added to the source files. While the Examiner contends that this feature is disclosed in Joyce et al., in actuality it is not.

More specifically, in Joyce et al., data specification information is stored in the data dictionary 20, which is a database provided separately from the source file 12. Thus, Joyce et al. does not disclose or suggest that data specification information required for converting source files into a calibrating file is *added to the source files*.

The above argued difference between the claimed device and method vis-à-vis the device and method of Joyce et al. undermine the factual determination that Joyce et al. identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of independent claims 1, 9 and 10, as well as of dependent claims 2 and 11, under 35 U.S.C. § 102 for lack of novelty as evidenced by Joyce et al. is not factually or legally viable and, hence, solicit withdrawal thereof.